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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,804	09/24/2001	Mari Kurosawa	SHI-015-USA-	8914

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,804

Applicant(s)

KUROSAWA ET AL.

Examiner

Lauren Q Wells

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4 are pending. The Amendment filed 12/10/02, Paper No. 11, amended claims 1-4.

Response to Arguments

Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection. However, to the extent that the arguments may be relevant to the instant rejection, the Examiner will address them below.

Applicant's amendment to the claims is sufficient to overcome the 35 USC 112 rejections in the previous Office Action.

Claim Rejections - 35 USC § 112

Claims 1-4 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation of a kit in claims 1-4 is new and was not recited in the original disclosure. The recitation, in claim 1, of "a regular reflection percentage of 1% or less in an amount of 1-100 wt.%, and a second powder, at least one of a regular reflection percentage and a diffuse reflection percentage of which is more than 5%, in an amount of less than 10 wt.%" is new and was not recited in the original disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The term "low" in claim 1 (part "(2)") is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(ii) Claim 1 is vague and indefinite, as it is confusing. What is a "first powder having a regular reflection percentage of 1% or less in an amount of 1-100 wt.%" referring to? 1-100% of what? What is a regular reflection percentage? What is "a second powder, at least one of a regular reflection percentage and a diffuse reflection percentage of which is more than 5% in an amount of less than 10 wt.% referring to? What powders are being claimed? The specification does not define these phrases and one of ordinary skill in the art would not be apprised of the meanings of these phrases.

(iii) Claim 4 is vague and indefinite, as it is confusing. Claim 1 recites a "first layer foundation composition consisting of" and claim 4 recites, "according to claim 1, wherein the first layer foundation composition (3) contains". How can a composition both "consist of" and "contain"?

(iv) Claim 1 is vague and indefinite, as it is not clear how a first layer foundation composition can consist of three different compositions, wherein each of the three compositions is a composition that "contains" different ingredients. If each of the three compositions are open-ended, how can the first layer foundation "consist of"?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-128122 in view of JP 9-194323.

JP '122 is directed to makeup compositions comprising a first layer foundation composition and a second layer finishing composition (summary at page 3). The second layer composition comprises a diffuse reflection powder such as methyl methacrylate, nylon and polyethylene, inter alia (sections 0018 to 0019 at page 10) in an amount from 5-100 wt.% (section 0022 bridging pages 11 and 12). For a second layer finishing composition containing spherical nylon powder see sections 0028-0029 at pages 14-15. For a first layer foundation composition containing silicone oil see Example 3 at page 18. The powders disclosed by JP '122 for use in the second layer composition are the same disclosed by Application as providing minimized regular reflection and diffuse reflection. See the instant specification at page 51, paragraph 2 for polymethyl methacrylate, polyethylene and nylon powders. The reference does not teach a first layer foundation composition containing a polyether-modified silicone, water and a hydrophobic powder in addition to the silicone oil.

JP '323 teaches a cosmetic composition containing a silicone oil, a polyether modified silicone of the formula instantly claimed, water and hydrophobic powder (page 3). For a make-up foundation composition containing the components instant claimed see Example 8 at page 22. The compositions of JP '323 provide light, refreshing feeling upon application without greasiness.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the foundation composition of JP '323 for the first layer foundation composition of JP '122 in order to provide a foundation composition with a light, refreshing feeling without greasiness.

Regarding the limitation of a kit, the Examiner respectfully points out that a composition must be contained, and that a product containing two separate compositions, as taught by both references, must be contained such that the product has two separate entities wherein the two compositions maintain their individuality. Thus, while JP '122 and JP '323 do not explicitly teach a kit, a kit is suggested. Furthermore, one of ordinary skill in the art would be motivated to generate a kit because of the ever present need to contain a single foundation product in a container wherein the fluid composition and the powder composition are joined.

Response to Arguments

Applicant argues, "the cited '122 reference fails to disclose or suggest that limiting a finishing layer containing a reduced amount of reflection powder, such as titanium oxide and mica, to no more than 10 wt% of the finishing layer, provides a natural appearance to the skin while simultaneously allowing the first layer of the multilayer composition to conceal irregularities in the skin". This argument is not persuasive, as it is not commensurate in scope with the instant claims which do not recite such a limitation.

Applicant argues, "The cited JP '323 reference teaches a cosmetic composition containing. . .but fails to teach a second layer finishing composition containing 1-100 wt.% of the reflection minimized powder and less than 10 wt.% of the reflection powder". This argument is not persuasive. The Examiner respectfully points out that JP '323 was relied upon as a

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secondary reference, wherein JP '122, the primary reference, teaches the second layer finishing composition.

Applicant argues that he has achieved unexpected results over the prior art. The Examiner respectfully directs Applicant to guidelines for showing unexpected results. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). In the instant case, Applicant has provided no data and no means of comparison. While Applicant has directed the Examiner to the Tables in the specification, The Examiner respectfully points out Applicant has not provided a comparison with the closest prior art and has not provided quantitative data of a statistical and practical significance.

Notes/Suggestions

In claims 1 and 4, the Examiner respectfully suggest that Applicant delete the period following the term "wt" so that it is clear that the claim does not end at the term "wt."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
March 3, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER 3/7/03